REMARKS

The Examiner required restriction under 35 U.S.C. § 121 between

Group I Claims 1-56 and 59-110, drawn to an etching method, classified in Class 216, Subclass 41, and

Group II Claims 57-58 and 111-112, drawn to a nozzle tool, classified in Class 156, Subclass 345.11.

The Applicant elects without traverse the claims of Group I, Claims 1-56 and 59-110. The Examiner rejected Claims 1-56 and 59-110 under 35 U.S.C. § 112, second paragraph as being indefinite for presenting an unreasonable number of claims in view of the nature and scope of the invention, thus being repetitious and causing confusion. The Examiner states that in his opinion, a total of 36 claims, including up to four independent claims, could have adequately covered the invention. The Applicant elects with traverse Claims 1-20.

The Applicant believes that the Examiner's rejection for undue multiplicity is both not in accordance with legal precedent and is also contradicted by the Examiner's own actions. First, for about 40 years, court decisions have been critical of multiplicity rejections. As stated in *Ex parte Birnbaum*,

> "The Examiner must show either that the claims are so unduly multiplied that they are difficult to understand, making examination almost impossible, or that the claims are for the most part duplicates." *Ex parte Birnbaum*, 161 USPQ 635, 637 (Pat. Off. Bd. App. 1968) ("While 40 pages of claims may seem to be unnecessarily prolix, the mere psychological reaction to this amount of material does not, in and of itself, constitute a legal basis for rejection.").

Likewise, in *In re Wakefield*, the court held that "there is no statutory authority for rejecting claims as being 'unnecessary'." *In re Wakefield*, 422 F.2d 897, 164 USPQ 636 (see PA 1970). The *Wakefield* court also stated that "an applicant should be allowed to determine the necessary

number and scope of his claims, provided he pays the required fees and otherwise complies with the statute." The *Wakefield* court found no obscuring multiplicity stating that

> "Each appealed claim is relatively brief and clear in its meaning. Examination of 40 claims in a single application may be tedious work, but this is not reason for saying that the invention is obscured by the large number of claims. We note that the claims were clear enough for the Examiner to apply references against all of them in his first Action." 162 USPQ 239.

In the current case, the Examiner has not shown that he was confused by the presentation of the claims in the case or that the public will be confused. Rather, the Examiner understood the claims well enough to be able to impose a restriction requirement on all of the claims. Furthermore, the Examiner admits that the claims are not duplicates, stating that "it is acknowledged that the independent claims differ from each other somewhat..." Therefore, the Examiner has refuted his own case that the number of claims causes confusion or is repetitious.

Second, the Examiner apparently feels that the number of claims is unreasonable because many of the dependent claims are identical to others that have been presented" and are thus repetitious and cause confusion. However, once again, the Examiner's position is impermissible in light of legal precedent. In *In re Flint*, the Board of Appeals argued that "even if features added by the dependent claims were to be found novel over the prior art, their repetition with more than one base claim differing only in scope is not justifiable." *In re Flint*, 411 F.2d 1353, 162 USPQ 228 (CCPA 1969). The *Flint* court disagreed stating "we are not prepared to judicially notice... that the dependent claims add only conventional elements commonly known. Moreover, the Board's statement acknowledges a difference in scope between the base claims...." and also stating that "...the claims differ from one another and we have no difficulty in understanding the scope of protection." 162 USPQ 230. Accordingly, the Examiner's position is clearly in error.

Based upon the above remarks, the Applicants request the Examiner to reconsider and withdraw the rejection under § 112 for undue multiplicity and to examine all of Claims 1-56 and 59-110. The Applicant also requests that the Examiner speedily provide a Notice of Allowance for the pending claims.

Respectfully submitted,

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